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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,115	11/06/2001	Andrew Divaker ShamRao		7461

7590 12/30/2004
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EXAMINER

CHUNG, JI YONG DAVID

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/992,115

Applicant(s)

SHAMRAO, ANDREW DIVAKER

Examiner

Ji-Yong D. Chung

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/18/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. For example, see line 10, page 14, in reference to "paypal.com." Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

2. The disclosure is objected to because of the following informalities: The specification incorporates co-pending applications, on lines 5-10, page 1, but the serial numbers for the co-pending applications have not been given. The serial numbers should be inserted.

The Examiner notes that the referenced application titled "SYSTEMS AND METHODS FOR ENSURING SECURITY AND CONVENIENCE" has been assigned Serial No. 09/992207, by the United States Patent and Trademark Office.

The referenced application titled "CONFIGURATION-DEPENDENT DOWNLOAD PROCESS" has been assigned Serial No. 09/992113.

The referenced application titled "HANDHELD COMPUTER SYSTEMS AND METHODS" has been assigned Serial No. 09/992109.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitations "the user" on line 3, "the device" on line 4, and "the computer" on line 6. There is insufficient antecedent basis for these limitations in the claim. Also, it is unclear if "the device" on line 4 and "the computer" on line 6 refer to the same feature. For the purpose of further examination, it will be assumed that "the device" and "the computer" refer to the same feature.

Claims 2-14 depend on claim 1 and are rejected for the same reason as claim 1.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-10, 16 and 17 are rejected under 35 U.S.C. 102(e)(2) as being anticipated by Kloba et al.

With regard to claim 1, Kloba et al. discloses:

“accepting a list of items selected by the user” (166A, Fig. 1F1.). Kloba et al.’s 166A box indicates that “user selects a page to view”, which, in the context of web page operation, involves clicking on an active element of the page, selecting it, and accepting the selection by the involved device;

“sending codes associated with the selected items from the device to the server” (166E, Fig. 1F1). Kloba et al.’s 166E shows the step in which “code” is sent to server; and

“receiving information from the server to the computer based on the matching codes.” (167F, Fig. 1F2 and lines 38-41, column 17). Kloba et al. shows the client that receives information from the server, provided the client has not cached the requested information.

With regard to claim 2, “topics on which the user wants more information” would be the page which Kloba et al.’s user has selected (lines 38-41, column 17). The user would not have selected the page unless he wanted more information.

Claim 3 attempts to further limit the “selected items” in claim 1. Claim 3 says that “selected items” are ones “associated with pre-specified code.” However, the cited limitation of claim 3 is inherent in any web page that has active elements, including the web pages shown by Kloba et al. (Fig. 1AB). Any active element on a web page, including the link to another page, has a corresponding code, either in binary or in text form, associated with it. When a mouse activates the link, the code is sent to the server from the browser.

With regard to claim 4, Kloba et al. discloses the step of “sending codes for selected items from the computer to the server” (166E, Fig. 1F2 and lines 63-67, column 16). Kloba et al. shows the step in which “tracking” information, which includes the user selections and corresponding code, is sent to the server.

With regard to claim 5, Kloba et al. meets the claim’s limitation of “requesting information from the local server with codes that match the codes sent by the computer” (174D and 175E, Fig. 1J). Kloba et al.’s client (Fig. 174A, Fig. 1J), or any browser, would request from the server with information (“code”) that was sent by the computer.

With regard to claim 6, Kloba et al. discloses the limitation “wherein the server returns only the information with associated codes that match the codes sent by the computer” (174E, Fig. 1J). Kloba et al.’s server would meet the limitation, because the web server returns only information that was requested and thus “match the codes sent by the computer”; otherwise, the web server would not function properly.

With regard to claim 7, Kloba et al. meets the limitation “wherein the information received from the server by the computer comprises advertisements.” (“Yahoo Classified-Listings” link, Fig. 10).

With regard to claim 8, Kloba et al. meets the limitation “wherein the advertisements sent by the server to the computer are transmitted based on the request of the user” (see SALES

DEMO, Fig. 14). The SALES DEMO information is retrieved when the user requests it, by clicking on the check box shown next to the SALES DEMO item in Fig. 14.

With regard to claim 9, Kloba et al. meets the limitation “wherein the advertisements that are pulled are relevant to the user” (SALES DEMO, Fig. 14). SALES DEMO, if it were downloaded, would be relevant to the user, because it would have been downloaded at the user’s request.

With regard to claim 10, Kloba et al. discloses the step in which “the user requests and receives information in real-time” (Fig. 1L). Kloba et al.’s synchronization module (178C, Fig. 1L) has to update information so that it reflects the user’s requests in real time. The updates are timely because the synchronization is made whenever there is a discrepancy between the locally cached values and the user’s selections.

With regard to claim 16, Kloba et al. discloses

“means for receiving codes representative of one or more desired items from one or more handheld devices” (COMPOSITE SERVER, Fig. 1V); and

“means for identifying information based on the code” (either web server mentioned in Figs. 1F-1L or WEB TO DEVICE SERVER in Fig. 1V); and

“means for sending the information to the handheld device” (workstation, Fig. IV).

With regard to claim 17, Kloba et al. discloses

“means for accepting a list of items desired by a user” (Fig. 1AB);

“means for sending predetermined codes associated with the selected items to a server to receive information from the server to the mobile device based on the codes” (BROWSER, Fig. 1Y); and

“means for displaying the information from the server to the user” (MOBILE DEVICE, Fig. 1U).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kloba et al. in view of Narayanaswami et al. Kloba et al. does not show the limitation in claim 15.

Narayanaswami et al., however, discloses the limitation, “generating one or more time-sensitive prompts and commands to alert the user in the event that the device has been left on without interaction for a predetermined period” (claim 30, lines 51-57, column 17).

In regard to the motivation for combining Kloba et al.’s device with Narayanaswami et al.’s invention, Narayanaswami et al. points out:

Computing, mobile and wireless communications technologies have been rapidly advancing – culminating in a variety of powerful user friendly devices such as personal digital assistants (PDA’s), cellular phones, pagers, etc. ...

Today, the industry is striving to provide advancements made by providing increased PC desktop-like functionality while *both decreasing size and power requirements*. [italics added]

(lines 29-13-27, column 1, Narayanaswami et al.)

It would have been obvious to one of ordinary skill in the art at the time of the invention consider implementing alarm feature of Narayanaswami et al. on Kloba et al.'s mobile device, to increase its functionality while decreasing size and power requirements.

9. Claims 11 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kloba et al. in view of Tanaka et al.

While claim 11 and claim 18 are directed to different statutory categories, the limitations of both claims involve a Personal Universal Memory (PUM). Kloba et al. does not show PUM. However, Tanaka et al. discloses a flash memory card adapted to be inserted into a mobile computer, the card comprising (FMC, Fig. 1):

“interface logic to communicate with the mobile computer” (22-pin flat electrodes, lines 47-56, column 5 and Fig. 1 in Tanaka et al.), and

“non-volatile data storage device” (FM, Fig. 1) coupled to the interface logic, the data storage device adapted to store a data structure to store personal information and preferences for customizing the device, wherein the mobile computer transitions from the basic mode to the customized mode upon the insertion of the PUM card into the mobile computer.

Tanaka et al.'s device meets the last limitation, because its flash memory is non-volatile, and it is coupled to the “interface logic” as shown in Fig. 1; once adapted into Kloba et al.'s mobile device, FMC would be used to store both personal and non-personal information (See

Fig. 52, Kloba et al. for the illustration of the mobile device storing user specific (“personal”) information, after configuration); plugging the memory into Kloba et al.’s device would “customize” the device, as it would hold user specific, customized information.

The motivation for combining or using Tanaka et al.’s FMC with Kloba et al.’s device is the suggestion in Tanaka et al.’s disclosure, lines 14-25, column 1, which mentions FMC’s use in PDA or portable information devices such as ones described in Kloba et al.

In view of the above, it would have been obvious to one of ordinary skill in the art at the time of the invention to use Tanaka et al.’s FMC with the mobile devices described in Kloba et al.

10. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kloba et al. and in view of Tanaka et al. as applied to claim 11 above, and further in view of Baird, III et al. (Baird hereafter).

With regard to claim 12, Kloba et al. does not disclose the claimed step: “storing an encrypted biometric identity image of a user’s biometric scan to compare against subsequent biometric scan”. However, Baird illustrates a personal digital assistant (Fig. 3) with a biometric input module. Baird’s feature would involve authentication procedure in which the encrypted biometric data is compared against the inputted biometric data. Note that information from the biometric scan is stored in memory module in encrypted form (Fig. 4 and lines 13-18, column 7),

The motivation for adding Baird's security feature to the Kloba et al. and Tanaka et al. is suggested in Baird's disclosure. See Fig. 3 and lines 43-66, column 5, where Baird's security feature is present in a PDA (101, Fig. 3) with flash memory (305, Fig. 3).

With regard to claim 13, Kloba et al. does not show the limitation "wherein the security image is compared with the biometric scan when security is necessary during login or during a transaction." However, Baird's authentication process for accessing preference database (see, from line 63, column 7 to line 21, column 8) meets the limitation. The motivation for combining Baird's feature with the combination of Kloba et al. and Tanaka et al. is as same as that given for the rejection of claim 12.

With regard to claim 14, Kloba et al.'s does not disclose the claimed step wherein "encrypted user identification and a password to further validate the user prior to using the PUM card." Baird shows an authentication procedure involving encrypted user identification and password for further validation prior to using personal preference database (see, from line 63, column 7 to line 32, column 8). The motivation for combining Baird's feature with the combination of Kloba et al. and Tanaka et al. is as same as that given for the rejection of claim 12.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ji-Yong D. Chung whose telephone number is (571) 272-7988. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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